

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Regarding the restriction requirement, while the Examiner is technically correct that the notice relates to restriction between a product and a process, whereas the claims here are drawn to an apparatus and a process, the logic of the former situation is still believed pertinent here. If the current claims to the device are found to be novel and unobvious, then also too must the current claims to the method of using the device be novel and unobvious—by definition. Under these circumstances, it occasions on the Examiner no serious search burden to examine the method claims after the claims to the device have been found to be allowable. Accordingly, in case the claims to the device are found to be allowable, the Examiner should rejoin and examine the method claims. If this procedure will not be followed, Applicants respectfully request that the Examiner unambiguously indicate this in the next Office Action.

The disclosure was objected to because section headings were missing. In response, Applicants point out that section headings are only a preferred layout of the specification, and are not mandatory. Applicants have added a Brief Description of the Drawings, but would prefer not to add other section headings.

Claims 1-3, 5, 6, 8 and 9 were rejected under 35 USC § 103(a) as being obvious over

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Ruebel, US 6,852,207, in view of Ehrhardt, US 3,307,972, and Palaika et al. ("Palaika"), US 6,248,225.

Claim 4 was rejected under 35 USC § 103(a) as being obvious over Ruebel in view of Ehrhardt and Palaika, and further in view of Grenon, US 4,251,327.

Claim 7 was rejected under 35 USC § 103(a) as being obvious over Ruebel in view of Ehrhardt and Palaika, and further in view of Kyriacou et al. ("Kyriacou"), US 4,217,185.

In response to all three obviousness rejections, Applicants submit that the cited combination of references does not make out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw all three prior art rejections.

Ruebel appears to be the equivalent of DE 198 45 506, which is discussed in the instant specification beginning in the last paragraph on page 1, and, therefore, represents no more than the acknowledged state of the art. The Examiner acknowledges that Ruebel does teach the use of an infrared heating system, but finds this is taught by Ehrhardt.

Applicants submit that Ehrhardt relates to a completely different technical field than Ruebel, and, thus, persons skilled in the art would not have combined Ruebel and Ehrhardt in the first place. Thus, Ruebel relates to galvanic metal deposition for dental applications, whereas Ehrhardt relates to electroless copper deposition for printed circuit boards. The two references,

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thus, relate to completely different technical fields, and a person skilled in the dental art, given Ruebel, would not have looked to the electroless copper deposition art, and Ehrhardt in particular, for teachings how to modify Ruebel.

Indeed, although Ehrhardt is nearly 40 years old, the Examiner has not been able to find a single reference in the dental field applying infrared heating technology, or even suggesting its application to galvanic metal deposition for dental applications. This supports Applicants' position that the present combination would not have been obvious.

Further, the Examiner says that persons skilled in the art would have been motivated to modify Ruebel's apparatus to include the infrared lamp of Ehrhardt "because heating the solution with the infrared lamp increases the electrodeposition rate." Respectfully, Applicants cannot find such teaching in the cited art, and respectfully request that the Examiner explain where such teaching can be found.

Ehrhardt does use an infrared light in his electroless copper deposition process. However, he does not appear to make any statements about the speed of such process vis-à-vis the same process except carried out with a hot plate, as in Ruebel. In the absence of such statements, motivation cannot be based on pure speculation that use of an infrared light increases the deposition rate. Certainly, Applicants have disclosed such an increase in their specification. However, Applicants' specification cannot be used against them to support this rejection.

According to *Manual of Patent Examining Procedure* ("MPEP") § 2143:

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"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Moreover, as reaffirmed by the Court in *In re Regel et al.*, 188 USPQ 136, 139, footnote 5 (CCPA 1975):

"The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination."

The Examiner has combined references from nonanalogous arts in an effort to make out a *prima facie* case, but has merely shown that components of Applicants' device were known to exist separately in the prior knowledge. There is present in none of the combinations of references either the motivation to use all of the components in the context of the dental art, or to combine the components into a device as presently claimed.

In view of the foregoing, Applicants believe that the Examiner would be fully justified to reconsider and withdraw all of the obviousness rejections. An early notice that these rejections have been withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

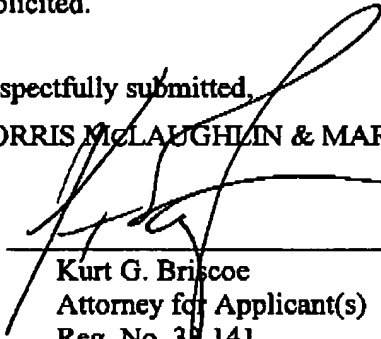
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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